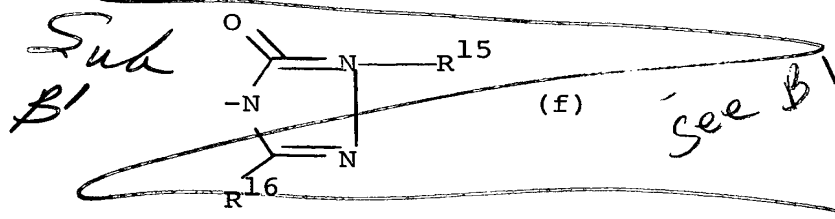


the radical Y is a 2,3-dihydro-4H-1,2,4-triazol-4-yl radical of the formula



*A' correct*

wherein R<sup>15</sup> is selected from the group consisting of lower alkyl and aryl lower alkyl and R<sup>16</sup> is selected from the group consisting of hydrogen, lower alkyl, and aryl lower alkyl; wherein said aryl as used in the foregoing definition is selected from the group consisting of phenyl and substituted phenyl, said substituted phenyl having from 1 to 3 substituents each independently selected from the group consisting of halo, lower alkyl, lower alkyloxy and trifluoromethyl.

#### REMARKS

Reconsideration is respectfully requested.

Claims 15 and 16 are newly presented; basis for these claims will be found on pages 2-5 of the specification.

#### A. "Improper Markush" Rejection

The rejection of Claims 1, 11, 12, and 13 as being directed to an "Improper Markush" is respectfully traversed. For the purpose of making a complete response, however, Applicants provisionally elect species Claims 4, 5, 8, 9, and 10 and newly-presented generic Claims 15 and 16. The elected species claims are all included within generic Claim 15.

The legal background in view of which any rejection of this type must be considered is provided by the landmark decisions of In re Weber, et al., 198 USPQ 328 (C.C.P.A. 1978) and In re Haas, 198 USPQ 334 (C.C.P.A. 1978). In the Weber case, generic claims had been rejected "as being improper Markush claims and (for) misjoinder under 35 USC 121." The Court

reversed the rejection under 35 USC 121 and remanded the rejection on "Improper Markush" for reconsideration by the Board of Patent Office Appeals. The Court held, however, that this consideration must be "consistent with our analysis of an Applicant's rights under the second paragraph of 35 USC 112," which allows an Applicant to claim the invention as he contemplates it.

It is therefore respectfully submitted that this rejection is improper in view of the Weber and Haas decisions since it prevents the instant Applicants from claiming their invention as they contemplate it. See In re Wolfrum, 179 USPQ 620 (C.C.P.A. 1973).

It is noted that the Examiner has not cited any statutory authority for his rejection, since it is clear from the Weber decision (and particularly from the concurring opinion of Judge Rich) that no such statutory basis exists for refusal to examine a claim.

Moreover, the citations by the Examiner supporting his rejection are not seen to provide the necessary legal foundation.

The Examiner's reliance on Section 706.03(y) of the Manual of Patent Examining Procedure is seen to be misplaced. First of all, the section does not cite any statutory authority for the procedure which it describes and is therefore merely a guide for Examiners and Applicants and has no legal effect upon Applicants, although it may determine PTO practice. Prior to the Weber and Haas decisions, this section cross-referenced Section 803 for a description of how restrictions under Markush-type claims should be instituted. Prior to the Weber and Haas decisions, Section 803 incorporated the information in the Commissioner's notice of 1974 (922 OG 1016), relying upon 35

USC 121 as the statutory basis. Since the Weber and Haas decisions, however, Section 803 of the MPEP has been cancelled, removing any color of statutory authority for such restriction practice.

The cases cited by the Examiner also do not appear to support his rejection. None of these cases in any way relate to improper Markush groups, but rather generally relate to the question of whether a Markush claim from which an anticipated member has been cancelled may be properly rejected. Since the Examiner has not cited any art in the present rejection, the relevance of these cases is not understood. The cases are dealt with individually below.

In re Hass and Susie, 60 USPQ 544 (C.C.P.A. 1944) relates in the portion referred to by the Examiner (Column 1 first paragraph) only to situations in which a generic Markush-type claim includes one or more members known to be old in the art. It is not seen that this portion of the Hass and Susie case has any relevance here, since the Examiner has not cited any prior art.

In re Application of Ayres, 129 USPQ 424 (C.C.P.A. 1936), which was referred to by the Examiner as 1936 C.D. 468, does not appear to relate at all to improper Markush groups, the issue there being merely a question of obviousness.

In re Ruff and Dukeshire, 118 USPQ 341 (C.C.P.A. 1958), referred to by the Examiner as 1958 C.D. 417, is also seen to lend no assistance to his position. This case also dealt with the question of cancellation of an anticipated member from a Markush group, similar to the above-referenced Ayres case. It is not seen that the issue discussed in the Ruff case has any applicability to the situation here at hand. The Examiner has not alleged that any of the compounds encompassed by the rejected

Markush Claim 1 are at all anticipated by any prior art. Moreover, the Ruff case commented adversely on the "Ayres doctrine", thus casting doubt upon the value of this entire line of decisions.

The final decision cited by the Examiner, Ex parte Bluestone, 1962 C.D. 450, is again related merely to an obviousness question and follows Ayres. This decision has no relevance to the issue in question here.

Finally, it is noted that the Examiner has not followed the Commissioner's notice entitled "Revised Practice Re Markush-Type Claims" published in 976 OG 128 (1978) as a response to the Weber and Haas decisions. Since this notice is stated to supersede the practice set out in 922 OG 1016 (1974), it is respectfully submitted that the Examiner should follow the procedure outlined in this Notice.

In any event, should the Examiner persist in this rejection, he is respectfully requested to indicate classes of compounds among which Applicants should elect. Although Applicants have provisionally elected species Claims 4, 5, 8, 9, and 10 and generic Claims 15 and 16, the guidance of the Examiner in framing a "proper Markush" is invited.

#### B. The 112 Rejection

The Examiner has also rejected Claims 1, 11, 12, and 13 under 35 USC 112 (first paragraph) apparently asserting that the specification provides no reasonable assurance that the claimed scope is operative for the utilities alleged. This is interpreted to be a rejection on failure to teach "how to use" the present invention.

Since the Examiner has provided no reasons why Applicants' statements are not to be believed, it is respectfully submitted that this rejection should be withdrawn. The Examiner

is referred to the leading case in this area, In re Marzocchi, et al., 169 USPQ 367 (C.C.P.A. 1971), in which a similar rejection to that under discussion herein was reversed by the Court on the ground that the Examiner had not sustained his burden of providing supporting evidence for the rejection.

In arriving at this holding, which is submitted to be controlling case law in this area, the Court stated:

"...A specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as in compliance with the enabling requirement of the first paragraph of Section 112 unless there is reason to doubt the objective truth of the statements contained therein... (emphasis in the original)"

After a discussion of factors which might provide reason to doubt the truth of such statements, the Court further said:

"In any event, it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to backup assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. (emphasis in the original)"

In view of this controlling case law, it is respectfully submitted that the Section 112 rejection of Claims 1, 11, 12, and 13 should be withdrawn unless the Examiner can support his rejection with acceptable evidence or reasoning which is inconsistent with the statements in the specification.

The case of In re Surrey, 151 USPQ 724 (C.C.P.A. 1966), cited by the Examiner during the prosecution of Applicants' parent application Serial No. 919,333, is also not seen to support the Examiner's position. The referenced portion of the Surrey decision indicates that the principal ground for that decision was the failure of the specification to make an

unequivocal statement that compounds other than those actually prepared and tested possessed the alleged utility. The Examiner is referred to the sentence bridging columns 1 and 2 on page 730 of the decision.

Completely contrary to the situation in the Surrey case, the present Applicants have made a positive affirmative statement that all of the compounds falling within the scope of the claim will possess the asserted utilities. The Examiner is referred to pages 32 through 38 of the specification, where it is stated that the compounds of formula (I) and the pharmaceutically-acceptable salts thereof are useful agents in combatting fungi and bacteria. A large number of fungi and bacteria against which the compounds and acid addition salts were found to be highly active is provided. In addition, illustrative data of the use of certain representative examples of the claimed compounds are provided. It is therefore respectfully submitted that any reliance upon Surrey as a ground for this rejection would be misplaced.


For further assistance in the interpretation of the first paragraph of Section 112 with regard to the requirements of "how to make" and "how to use", the Examiner is also referred to the decision of In re Robins, 166 USPQ 552 (C.C.P.A. 1970).

#### C. Conclusion

For the reasons set out above, it is respectfully submitted that both the "Improper Markush" and Section 112 rejections should be withdrawn and all claims allowed. It is noted that no prior art has been cited which would affect the allowability of the claims.

For the convenience of the Examiner in following the remarks herein, copies of all decisions newly referred to by the Attorney have been provided.

Respectfully submitted,

  
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See also 175 USPQ 217, 179 USPQ 623, and 188 USPQ 374.

Stanley H. Mervis, Cambridge, Mass., for appellant.

Charles A. Wendel, Arlington, Va., Karl F. Jorda, Ardsley, N.Y., and Harold C. Wegner, Washington, D.C. (Earl L. Tyner, Arlington, Va., and Harry E. Westlake, Jr., Rahway, N.J., of counsel) for amicus curiae.

Joseph F. Nakamura (Fred E. McKelvey, of counsel) for Commissioner of Patents and Trademarks.

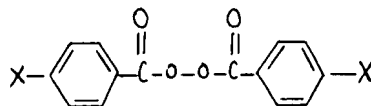
Before Markey, Chief Judge, and Rich, Baldwin, Lane, and Miller, Associate Judges.

Markey, Chief Judge.

This appeal is from a decision of the United States Patent and Trademark Office (PTO) Board of Appeals (board) affirming a final rejection under 35 USC 121 of claims 7 and 8 of application serial No. 821,511, filed May 2, 1969, entitled "Novel Polymerization Initiators."<sup>1</sup> We reverse and remand.

#### Invention

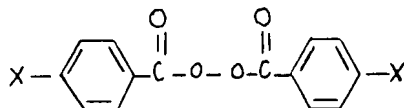
The invention is a group of benzoyl peroxides:



useful as initiators for polymerization of vinyl-containing compounds or monomers. Haas states: "The substituent X does not participate in the polymerization initiation, but it does introduce into the resulting polymer a reactive, terminal group at one or both ends of the resulting polymer chain. Thus, while the resulting polymers may have different utilities, all of the resulting compounds have the same utility, [i.e., polymerization initiators]."

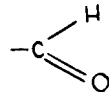
Claims 7 and 8 are the sole claims on appeal:

7. A compound of the formula



<sup>1</sup> A continuation-in-part of serial No. 630,222, filed April 12, 1967.

wherein X is selected from the group consisting of  $\alpha$ -monosubstituted chloro, bromo and fluoro alkyl groups containing from 1-3 carbon atoms, inclusive; and



8. The invention of claim 7 wherein X is selected from the group consisting of  $\alpha$ -monosubstituted chloro alkyl groups containing from 1-3 carbon atoms, inclusive; and



#### Background

Haas comes before this court for the second time on the present application. In *In re Haas*, 486 F.2d 1053, 179 USPQ 623 (CCPA 1973) (Haas I), the examiner held claims 1 and 2 withdrawn from further consideration under 35 USC 121 as drawn to "multiple patentable [sic, patentably] distinct inventions."<sup>2</sup> This court held that "withdrawal" of a claim from consideration, under those circumstances, constituted a rejection reviewable by the board under 35 USC 7 and 134, and by this court under 35 USC 141. The decision of the board to dismiss for lack of jurisdiction was reversed, and the case was remanded for further action consistent with the opinion.

The board remanded the case to the examiner. The examiner rejected claims 1 and 2 "as improper Markush claims and for misjoinder [of invention] under 35 USC 121" because drawn to multiple "independent and distinct" inventions. Though initially arguing that claims 1 and 2 did not define "independent and distinct" inventions, Haas expressly abandoned that argument on appeal to the board and conceded "that his recited Markush group contains 'multiple independent and distinct inventions' in the same sense that a generic term may contain multiple independent and distinct inventions." In view of that concession, the board stated: "[T]he only question presented by this appeal is whether or not a single claim which includes a plurality of independent and distinct inventions is legally rejectable."<sup>3</sup> The board answered affirmatively.

<sup>2</sup> Claim 2 was dependent from claim 1 and limited substituent X to the para position of the benzene rings. The "independent and distinct" inventions were thus alleged to fall within claim 1 alone or claims 1 and 2 taken together.

<sup>3</sup> Ex parte Haas, 188 USPQ 374, 376 (PTO



In its opinion, the board viewed the examiner's rejection as based on claiming an improper Markush group and misjoinder of invention under 35 USC 121. In affirming the examiner's rejection as based on claiming an improper Markush group, the board said "[w]hether or not there is a statutory basis for such a rejection is of no real concern, since such a rejection has basis at least in established judicial doctrine,"<sup>4</sup> and that it was unnecessary to decide whether §121 provided a basis for rejection. The board, nonetheless, proceeded to decide that question. In the board's opinion, §121 did provide a basis for rejection because "[t]he statute \* \* \* broadly permits the Commissioner, in his discretion, to refuse to grant a patent on an application containing two or more independent and distinct inventions."<sup>5</sup> Additionally, the board entered rejections under 37 CFR 1.196(b) based upon §102(b), §112, first paragraph, and §112, second paragraph. One board member, dissenting-in-part, stated that he did not agree that "independent and distinct inventions" were claimed, despite Haas' admission.

Haas elected to carry on further prosecution before the examiner, 37 CFR 1.196(b). Following an amendment adding two claims numbered 6 and 7, the examiner finally rejected claims 1, 2, 6 and 7, *inter alia*, "as improper Markush claims and misjoinder under 35 USC 121." Other rejections included *res judicata* (claims 1 and 2), 35 USC 132 (claims 6 and 7, new matter), and 35 USC 102(b) (claims 1, 2, 6 and 7). A claim 5, apparently originally allowed, was rejected under 35 USC 112, first paragraph, because the board's §1.196(b) rejection under §112, first paragraph, of claims 1 and 2 applied to claim 5 as well. Haas proposed present claim 8 in an after-final amendment, 37 CFR 1.116, entered by the examiner with the understanding that claim 8 stood rejected for the same reasons applied to claims 5, 6 and 7.

On appeal, under a heading "35 USC 121 Rejection," the board stated: "This rejection, as acknowledged by the appellant, raises the same issues as were involved in the Examiner's rejection under 35 USC 121 involved in the previous appeal." Noting that Haas had not raised any additional arguments and relied upon arguments made in the previous appeal, the

board affirmed the rejection "for the reasons given by us [in the previous appeal]." The board proceeded to reverse the §132 rejection, the *res judicata* rejection, and the §102(b) rejection as to claims 7 and 8, but affirmed the §102(b) rejection as to claims 1, 2, 5 and 6, and affirmed the §112, first paragraph rejection of claims 1, 2, 5 and 6. The board further entered a 37 CFR 1.196(b) rejection of claims 1, 2, 5, 6, 7, and 8 under 35 USC 112, second paragraph. The dissenting board member in the previous appeal filed a concurrence again expressing his opinion that the claims, particularly claims 7 and 8, did not recite independent and distinct inventions, but agreed to the result in view of Haas' concession.

Prosecution again returned to the examiner. Haas cancelled claims 1, 2, 5 and 6, rewrote claim 7 in independent form, and otherwise amended the claims mooting all issues save the issue under §121. Thus, on the third and final appearance before the board, only claims 7 and 8 remained and stood rejected "under 35 USC 121 as containing improper Markush groups and misjoinder of inventions in the combination of the members in said Markush groups." In that appearance, the board made final its previous decision affirming that rejection.

#### Issue

[1] The claims are solely rejected under 35 USC 121 in accordance with the mandate in the Manual of Patent Examining Procedure (MPEP) 803 as containing "improper Markush groups and [for] misjoinder of inventions" because those claims are viewed as directed to independent and distinct inventions.<sup>6</sup> Accordingly, the issue is whether §121 furnishes a basis for rejecting a claim.

#### Opinion

[2] In *In re Weber*, 198 USPQ 328, decided of even date, this court holds that §121 does not provide a basis for rejection of a claim. To the extent that §121 was employed in this case as a basis for rejection, that rejection is, on the authority of *Weber*, reversed.

Bd. App. 1975).

<sup>4</sup> *Id.*

<sup>5</sup> *Id.* at 377.

<sup>6</sup> There is no rejection and, consequently, no issue before us that the claims are drawn to improper Markush groups as described by the PTO in MPEP 706.03(y).

The examiner's rejection of claims 7 and 8 herein as "improper Markush" claims is inextricably intertwined on this record with the application of §121. The solicitor's brief states that the examiner is willing to examine claims 7 and 8 as a whole on their merits.

Accordingly, the decision of the board is reversed and the case is remanded for examination of claims 7 and 8 on their merits.

*Reversed and Remanded*

#### Court of Customs and Patent Appeals

In re The Clorox Company

No. 77-628

Decided June 30, 1978

#### TRADEMARKS

##### 1. Registration — In general (§67.731)

###### Registration — Supplemental Register (§67.765)

Examiner of Trademarks and Patent and Trademark Office Trademark Trial and Appeal Board are charged, under Lanham Act Section 2(d), with duty of refusing registration of mark, whose use is likely to cause confusion because of its resemblance to mark registered in Patent and Trademark Office; Lanham Act Section 23 indicates that Supplemental Register is continuation of register provided in paragraph (b) of Section 1 of Act of March 19, 1920; Section 2(d)'s absence from enumeration of statutory provisions made inapplicable to Supplemental Register establishes unequivocally its applicability to registrations on Supplemental Register.

##### 2. Identity and similarity — In general (§67.401)

###### Identity and similarity — How determined — In general (§67.4051)

###### Registration — In general (§67.731)

Protection envisaged by Trademark Act Section 2(d) is not that of marks against mere registration of other marks, hence conflict must occur in marketplace; refusal to register conflicting mark does not protect registered mark against use of con-

flicting mark in marketplace; users of trademarks and owners of registrations, when they seek protection of their marks, are necessarily protecting their right to unconfused public, and are serving statutory goal of protecting public against confusion; sole duty of Trademark Examiner, Trademark Trial and Appeal Board, and Court of Customs and Patent Appeals, under Trademark Act Section 2(d), is to determine whether confusion is likely; confusion sought to be prevented by Trademark Act is not that of examiners, lawyers, board members, or judges; confusion is likely, if at all, only in marketplace where marks are used; registration is itself incapable of causing confusion; Patent and Trademark Office is not charged under Trademark Act Section 2(d) with duty of permitting or denying right to use any mark, or of protecting any registered mark against mere registration of similar marks, unless use of latter would be likely to cause confusion.

##### 3. Identity and similarity — How determined — In general (§67.4051)

###### Registration — Supplemental Register (§67.765)

###### Statutes and treaties (§67.80)

Mark registered on Supplemental Register can be used as basis for refusing registration to another mark under Trademark Act Section 2(d); resort to legislative history is unnecessary where Trademark Act language is clear and unambiguous.

##### 4. Cancellation — In general (§67.171)

###### Registration — Supplemental Register (§67.765)

Marks registered on Supplemental Register are required to be capable of distinguishing applicant's goods or services under Trademark Act Section 23; party has cancellation proceeding available under 15 U.S.C. 1092 if registrant was not entitled to registration, on grounds that mark is common descriptive term and thus incapable of indicating origin of goods, or because mark is not used by registrant or has been abandoned.

**Court of Customs and Patent Appeals**

In re Weber, Soder, and Boksay

No. 77-622

Decided June 30, 1978

**PATENTS****1. Court of Customs and Patent Appeals — Jurisdiction (§28.25)**

Court of Customs and Patent Appeals has jurisdiction over "improper Markush claims" rejection and Section 121 rejections.

**2. Claims — Broad or narrow — In general (§20.201)**

Applicant is given, by statute, right to claim his invention, with limitations he regards as necessary to circumscribe invention, with proviso that application comply with requirements of Section 112.

**3. Applications for patent — Divisional (§15.5)****Joinder of invention — In general (§42.01)**

Applicant has right to have each claim examined on merits, as general proposition; it may well be that pursuant to proper restriction requirement that number of claims submitted in one application will be dispersed to number of applications; such action would not affect right of applicant eventually to have each of claims examined in form he considers to best define his invention; however, single claim that is required to be divided up and presented in several applications would never be considered on its merits; totality of resulting fragmentary claims would not necessarily be equivalent of original claim; further, it is not inconceivable that number of fragments would not be described in specification, since subgenera would be defined by examiner rather than by applicant.

**4. Applications for patent — Divisional (§15.5)****Commissioner of Patents — In general (§21.01)****Joinder of invention — In general (§42.01)****Pleading and practice in Patent Office — Rejections (§54.7)**

Section 121 provides Commissioner of Patents and Trademarks with authority to promulgate rules designed to restrict application to one of several claimed inven-

tions when those inventions are found to be "independent and distinct"; however, it does not provide basis for examiner acting under Commissioner's authority to reject particular claim on that same basis.

**5. Applications for patent — Divisional (§15.5)****Claims — Broad or narrow — Markush type — In general (§20.2051)****Commissioner of Patents — In general (§21.01)****Joinder of invention — In general (§42.01)****Pleading and practice in Patent Office — Rejections (§54.7)**

Patent Office must have some means for controlling such administrative matters as examiner caseloads and amount of searching done per filing fee, even though statute allows applicant to claim his invention as he sees fit; Commissioner of Patents has authority to "establish charges for \* \* \* services furnished by the Patent and Trademark Office," under 35 U.S.C. 41(b); statutory rights are paramount in drawing priorities between Commissioner as administrator and applicant as beneficiary of his statutory rights; rejection of claims under Section 121 violates basic right of applicant to claim his invention as he chooses.

**6. Joinder of invention — In general (§42.01)****Pleading and practice in Patent Office — Rejections (§54.7)**

Restriction requirement and subsequent action of examiner in withdrawing nonelected claims from consideration does not, per se, constitute rejection; however, In re Haas, 179 USPQ 623, in which examiner's action in withdrawing claims was rejection, since "claims were withdrawn from consideration not only in this application but prospectively in any subsequent application because of their content," is exception.

**Particular patents — Diamine Derivatives**

Weber, Soder, and Boksay, Cyclic Diamine Derivatives, rejection of claims 1-6, 16, 17, 20, and 22 reversed and remanded; appeal of claims 8-13, and 23 dismissed.

Appeal from Patent and Trademark Office Board of Appeals.

Application for patent of Rolf-Ortwin Weber, Alfons Soder, and Istvan Boksay, Serial No. 307,406, filed Nov. 11, 1972. From decision rejecting claims 1-6, and dismissing appeal as to claims 8-13, 16, 17, 20, 22, and 23, applicants appeal. Reversed and remanded; Rich, Judge, concurring with opinion.

David R. Murphy, Arlington, Va., for appellants.

Charles A. Wendel, Arlington, Va., and Harold C. Wegner, Washington, D.C., for Patent, Trademark, and Copyright Section, Virginia State Bar, amicus curiae.

Joseph F. Nakamura (Fred E. McKelvey, of counsel) for Commissioner of Patents and Trademarks.

Before Markey, Chief Judge, and Rich, Baldwin, Lane, and Miller, Associate Judges.

Baldwin, Judge.

This appeal is from a decision of the United States Patent and Trademark Office (PTO) Board of Appeals (board) affirming the examiner's rejection of claims 1-6 "as being improper Markush claims<sup>1</sup> and misjoinder under 35 USC 121."<sup>2</sup>

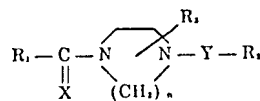
The board also dismissed, for want of jurisdiction, the appeal of claims 8-13, 16, 17, 20, 22 and 23 in that the claims "were withdrawn from consideration since they were directed to non-elected inventions." We reverse and remand.

#### Invention

The invention relates to cyclic diamine derivatives which possess the common property of psychotherapeutic effective-

ness. The derivatives are identified by a single generic formula expressed in Markush format in representative claim 1:

1. A compound having the general formula



or an acid addition salt thereof in which formula  $R_1$  is selected from the group consisting of

- A) an at least mononuclear heterocyclic group having 4 to 10 carbon atoms in the ring system bound to the group  $-C-$  through a carbon atom and

containing at least one oxygen, nitrogen or sulphur atom.

- B) substitution products of A) containing at least one substituent selected from the group consisting of halogen, trifluoromethyl, hydroxy, alkoxy of 1 to 3 carbon atoms, unsubstituted amino, amino substituted by up to two alkyl groups each having 1 to 3 carbon atoms and alkyl groups having 1 to 6 carbon atoms,

X is oxygen, sulphur or an NH-group,

Y is an alkylene group having 1 to 3 carbon atoms in the chain, or an alkylene group having 1 to 3 carbon atoms in the chain substituted by a) up to 3 alkyl groups each having up to 3 carbon atoms and a total of not more than 8 carbon atoms, or b) substituted by one or two phenyl groups,

$R_2$  is selected from the group consisting of

- C) an at least mononuclear carbocyclic or heterocyclic group having 4 to 10 carbon atoms in the ring system, containing but one heteroatom in a ring,

- D) substitution products of C) containing at least one substituent selected from the group consisting of nitro, halogen, trifluoromethyl, alkyl having 1 to 6 carbon atoms, hydroxy, alkoxy having 1 to 3 carbon atoms, unsubstituted amino groups and amino groups substituted by up to two alkyl groups each having 1-3 carbon atoms,

$R_3$  is hydrogen or up to two substituents selected from alkyl groups having up to 2 carbon atoms and phenyl groups;

<sup>1</sup> Section 706.03(y) (note 4, *infra*) of the Manual of Patent Examining Procedure (MPEP) provides guidance in the use of Markush format and is cited by the examiner in his Answer before the board. MPEP 803 (note 3, *infra*), which applies 35 USC 121 to Markush claims, is also cited by the examiner in his final office action.

<sup>2</sup> Section 121 provides, in pertinent part:

#### Divisional applications

If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application.

n is 2 or 3.

### Background

In the first office action dated January 17, 1974, the examiner "objected" to claims 1-6, 8-13 and 23 and required applicants to elect one of three groups of claims: group I (claims 7 and 14-22), group II (claims 8-13), or group III (claim 23). Applicants elected, with traverse, group I and brought to the examiner's attention his failure to include claims 1-6 in the groups. The status of claims 1-6 was clarified in the second and final action, dated December 26, 1974, in which those claims were "rejected." The examiner also stated that claim 1 embraced 24 enumerated independent and distinct inventions. The examiner, in conclusion, stated that:

Markush claims 1 to 6 are rejected as being improper Markush claims and for misjoinder under 35 U.S.C. 121, (922 O.G. 1016, 4th and 6th paragraph).<sup>3</sup>

<sup>3</sup> The examiner exercised his discretion under 922 O.G. 1016 which was a notice issued by the Commissioner on May 1, 1974, (now MPEP 803) which provides in part:

A Markush-type claim is directed to "independent and distinct inventions," if two or more of its members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 35 U.S.C. 103 with respect to the other member(s).

[Paragraph 4.]

If the claim is of that nature, the examiner is authorized to reject it as an improper Markush claim and for misjoinder under 35 U.S.C. 121 and to require the applicant to restrict the application to a single invention. In making such a requirement, the examiner will (1) clearly delineate the members or groups of members believed to constitute improperly joined inventions, and (2) state reasons fully explaining why they are independent and distinct. Applicant's response to such a requirement should be an election of a single adequately disclosed and supported invention, with or without restriction of the claim(s) to that invention. Of course, the response must not introduce new matter into the application. See 35 U.S.C. 132 and *In re Welstead*, 59 CCPA 1105, 463 F.2d 1110, 174 USPQ 449 (1972). A refusal to elect a single invention will be treated as a non-responsive reply.

If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner is encouraged to examine it on the merits, even though it is directed to independent and distinct inventions. In such a case, the examiner will not follow the procedure outlined in the preceding paragraph

In his Answer, the examiner expanded upon the basis of the rejection. He discussed MPEP 803, in particular the phrase "independent and distinct" of §121 and applied the phrase to the claims. Continuing, the examiner discussed the Markush claims and stated:

The compounds embraced do not have a common nucleus and are improperly Markushed under the criteria set forth in M.P.E.P. 706.03(y) \* \* \*  
\* \* \* The specification discloses that certain compounds have activities not shared by all of the scope claimed \* \* \*.

and will not require restriction.

[Paragraph 6.]

Where the examiner has rejected the claim and required restriction and the applicant has responded without restricting the claim(s) to a single invention, the examiner shall, if the position is adhered to, again reject the claim and any other Markush claims not restricted to the elected invention. No further examination of these claims is required unless and until such rejection has been overcome. However, if the search of the single elected invention develops prior art which would render both the elected invention and the improper Markush claim(s) unpatentable, such prior art may be applied in rejections of both without a complete search of the subject matter of the improper Markush claim(s). Otherwise, only true generic claims and those restricted to the elected invention will be examined in the usual manner.

[Paragraph present in MPEP 803 deleted.]

Review of the rejection will be by appeal to the Board of Appeals under 35 U.S.C. 134.

<sup>4</sup> MPEP 706.03(y) provides, in pertinent part:

Ex parte Markush, 1925 C.D. 126; 340 O.G. 839, sanctions, in chemical cases, claiming a genus expressed as a group consisting of certain specified materials. This type of claim is employed when there is no commonly accepted generic expression which is commensurate in scope with the field which the applicant desires to cover. \* \* \*

Where a Markush expression is applied only to a portion of a chemical compound, the propriety of the grouping is determined by a consideration of the compound as a whole, and does not depend on there being a community of properties in the members of the Markush expression.

When materials recited in a claim are so related as to constitute a proper Markush group, they may be recited in the conventional manner, or alternatively. For example, if "wherein R is a material selected from the group consisting of A, B, C and D" is a proper limitation then "wherein R is A, B, C or D" shall also be considered proper.

At the outset, the board decided that §121 was an adequate legal basis for the examiner to reject a single claim "embracing" more than one independent and distinct invention. In support thereof, the board incorporated two board decisions<sup>5</sup> which discussed the interrelated rejections of "misjoinder under 35 U.S.C. 121" and "as being improper Markush claims" as applied here. The board analyzed the claims in light of those decisions and found them to contain multiple independent and distinct inventions.

Appellants argue before this Court that each of the claims is directed to but a single invention and §121 is not a proper ground for rejection in any event.

### Opinion

[1] The board affirmed the examiner's rejection of claims 1-6 "as being improper Markush claims and misjoinder under 35 U.S.C. 121." However, the reasoning of the board shows that the analysis of the "improper Markush claims" rejection was to be supportive of the rejection under §121 rather than alternative to it. We have jurisdiction over both rejections,<sup>6</sup> but

<sup>5</sup> The board incorporated both *Ex parte Dorlars*, Appeal No. 148-56, decided May 2, 1975, reproduced in the record, and *Ex parte Haas*, 188 USPQ 374 (Bd. App. 1975). The board stated in *Dorlars* that:

What we do find relevant is the single question: does the Examiner have legal authority to attack the propriety of an individual claim, whether of the Markush-type or otherwise, which includes a plurality of independent and distinct inventions? We think clearly the answer is "yes."

The board based its conclusion in *Dorlars* on §121 and further stated:

Clearly the mere fact that review of decisions requiring restriction within a single claim is available under 35 USC 134, whereas decisions requiring restriction between claims are not, cannot serve to limit application of the statute. That relates only to the issue of jurisdiction to review; it has no bearing on the scope of the statute itself — on the scope of authority conferred. In *Ex parte Haas*, the board decided that Rule 141, 37 CFR 1.141 regards an allowable generic claim as one that does not include more than one independent and distinct invention. The board decided that §121 is a legal basis for rejecting a single claim as an improper Markush claim.

<sup>6</sup> 37 CFR 1.196(a) provides that in decisions of the board:

The affirmation of the rejection of a claim on any of the grounds specified constitutes a general affirmation of the decision of the pri-

mary examiner on that claim, except as to any ground specifically reversed.

See also *In re Siebert*, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977).

[2] An applicant is given, by the statute, the right to claim his invention with the limitations he regards as necessary to circumscribe that invention, with the proviso that the application comply with the requirements of §112. We have decided in the past that §112, second paragraph, which says in part "[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention," allows the inventor to claim the invention as he contemplates it. *In re Wolfrum*, 486 F.2d 588, 179 USPQ 620 (CCPA 1973).

[3] As a general proposition, an applicant has a right to have *each* claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the right of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification.<sup>7</sup>

[4] It is apparent that §121 provides the Commissioner with the authority to promulgate rules designed to *restrict an application* to one of several claimed inven-

tion, except as to any ground specifically reversed.

See also *In re Siebert*, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977).

<sup>7</sup> See *Fields v. Conover*, 58 CCPA 1366, 443 F.2d 1386, 170 USPQ 276 (1971), wherein a subgenus was not described and *In re Ruschig*, 54 CCPA 1551, 379 F.2d 990, 154 USPQ 118 (1967), wherein a species of a properly described genus was found not to be described.



tions when those inventions are found to be "independent and distinct." It does not, however, provide a basis for an examiner acting under the authority of the Commissioner to *reject* a particular claim on that same basis.

[5] Even though the statute allows the applicant to claim his invention as he sees fit, it is recognized that the PTO must have some means for controlling such administrative matters as examiner caseloads and the amount of searching done per filing fee.<sup>8</sup> But, in drawing priorities between the Commissioner as administrator and the applicant as beneficiary of his statutory rights, we conclude that the statutory rights are paramount. We hold that a rejection under §121 violates the basic right of the applicant to claim his invention as he chooses.

[6] Appellants contend that the examiner's action in withdrawing claims 8-13, 16, 17, 20, 22 and 23 from consideration as drawn to nonelected inventions constitutes a rejection under the holding of *In re Haas*, 486 F.2d 1053, 179 USPQ 623 (CCPA 1973), and, therefore, the board improperly found a lack of jurisdiction. We do not agree. Clearly our decision in *In re Hengehold*, 58 CCPA 1099, 440 F.2d 1395, 169 USPQ 473 (1971), disposed of the theory that a restriction requirement and the subsequent action of the examiner in withdrawing nonelected claims from consideration,<sup>9</sup> per se, constitutes a rejection.

An exception is found in *In re Haas*, supra, wherein we determined that the examiner's action in withdrawing claims was a rejection because the "claims were withdrawn from consideration not only in this application but prospectively in any subsequent application *because of their content*." 486 F.2d at 1056, 179 USPQ at 625. (Emphasis ours.) We do not understand the PTO to make such a holding with respect to claims 8-13, 16, 17, 20, 22 and 23, nor that appellants argue that the PTO does so. Indeed, we note that appellants admitted in their brief before the board that claims 8-13 and 23 were "properly withdrawable." Consequently, the board's dismissal of the appeal to claims 8-13 and 23 was correct. The Commissioner's brief admits that claims 16, 17, 20 and 22 contain species of the invention of generic claim 1 and would be provided an examination on the merits should the §121 rejection be reversed. We remand for appropriate action on claims 16, 17, 20 and 22, and dismiss the appeal of claims 8-13 and 23 for lack of jurisdiction.

The decision of the board affirming the rejection under §121 is *reversed*, and the case is *remanded* for consideration of the "improper Markush" rejection of claims 1-6 and appropriate action on claims 16, 17, 20 and 22. The appeal of claims 8-13 and 23 is *dismissed* for lack of jurisdiction.

*Reversed and Remanded*

Rich, Judge, concurring.

I concur in the result reached in the main opinion, but there are a few points I wish to make clear.

35 USC 121 deals with a matter of PTO practice known as "requirements for division" prior to the 1952 Patent Act which, for the first time, provided a statutory provision on this subject. It did so, under the heading "Divisional Applications," by giving the Commissioner a discretionary, unappealable power to *restrict* an application to one of several *claimed* inventions when those inventions were found to be "independent and distinct." 35 USC 121, first sentence; see also P. J. Federico, "Commentary on the New Patent Act" 35 USCA p. 1, at p. 34 (1954).

not elected, if not canceled, are nevertheless withdrawn from further consideration by the examiner by the election, subject however to reinstatement in the event the requirement for restriction is withdrawn or overruled.

<sup>8</sup> We take notice of a practice formerly utilized by the PTO and found in the MPEP:

705 Patentability Reports

Where an application, properly assigned to one examining group, is found to contain one or more claims per se classifiable in one or more other groups, which claims are not divisible inter se or from the claims which govern classification of the application in the first group, the application may be referred to the other group or groups concerned for a report as to the patentability of certain designated claims. This report will be known as a Patentability Report (P.R.) and will be signed by the primary examiner in the reporting group.

The report, if legibly written, need not be typed.

Note that the Patentability Report practice is suspended, except in extraordinary circumstances. See §705.01(e).

We further note the authority of the Commissioner under 35 USC 41(b) to "establish charges for . . . services furnished by the Patent and Trademark Office."

<sup>9</sup> 37 CFR 1.142(b) provides:

(b) Claims to the invention or inventions

Ever since *Ex parte Eagle*, 1870 C.D. 137 (Com'r. Pats. 1870), at least, the expression used in §121, "two or more \* \* \* inventions are claimed," has connoted separate claims to separate inventions. It has no reference to generic or broad claims which "embrace" (the term used by the examiner and the board herein) or "cover" (the term used in the solicitor's brief in support of the board) two or more inventions. Section 121 nowhere uses the words "embraced" or "covered." It says "claimed," and that I take to mean what it has always referred to in the terminology of the patent law, a "claim" or definitional paragraph which, in the words of §112, second paragraph, is "particularly pointing out and distinctly claiming the subject matter the applicant regards as his invention."

Dealing, as it does, with requirements for restriction, §121 says nothing whatever about the rejection of claims, a matter entirely separate from restriction. For one thing, rejections are appealable to the board and restriction requirements are not. *Federico*, op. cit. p. 34; 37CFR§1.144.

On this appeal from the rejection of claims 1-6 we do not have before us a restriction requirement under §121. Such a requirement would not have been appealable to the board. We have before us an appeal from affirmance of a rejection. The examiner purported to base it on §121 and the board accepted that theory, citing in support its own prior decision in *Ex parte Haas*, 188 USPQ 374, wherein it had said, "We believe the referred to section of the patent statute [§121] does provide a basis for such a rejection," namely, a rejection of a single claim "drawn to a multiplicity of independent and distinct inventions."<sup>1</sup>

In dealing with claims 1-6, in spite of the fact there are multiple claims, we are not dealing with separate claims to separate inventions. Claim 1 is a generic claim and claims 2-6 are dependent thereon. They are all generic claims but of varying scope. They are treated together and each claim is rejected on the same ground, as being drawn to multiple allegedly independent and distinct inventions. Careful review of all statements by the examiner and the board makes it clear beyond question that

the only basis asserted for rejecting claims 1-6 is that they cover or embrace or are directed to a plurality of independent and distinct inventions, and this is the sole reason given for saying they are "improper Markush claims" or for saying there is "misjoinder [of inventions] under 35 USC 121." Section 121 is asserted as the *only* legal basis for this rejection.<sup>2</sup>

The practice here challenged is tantamount to a refusal by the PTO to examine a single Markush claim in a single application because, in its opinion, it is broad enough to "embrace" or "cover" a plurality of inventions which, if presented separately, would be separately patentable, assuming any one of them to be prior art.<sup>3</sup> The label it attaches to such a broad claim is "improper Markush" and the situation is described as "misjoinder."

The fault in the PTO position is that it overlooks the obvious fact that almost any reasonably broad claim "embraces" or "covers" a multiplicity of inventions, in the sense of "dominating" them, which inventions might be separately patentable if and when presented in separate applications. Logically, this is not a sufficient excuse for refusing to examine a claim on its merits for compliance with 35 USC 101, 102, 103, and 112. None of those statutory sections, of course, justifies a refusal to examine.

The only justification or statutory authority put forward for refusing to examine is 35 USC 121. There is nothing therein, however, to excuse a refusal to examine an elected invention or an applicant's generic (broad) claim reading thereon, notwithstanding the generic claim reads on nonelected inventions and possibly many others, all potentially separately patentable. The PTO's own rules recognize the distinction between generic claims and separately patentable inventions encompassed or covered thereby. 37

<sup>2</sup> In addition to §121, the examiner relied on the Commissioner's notice published May 1, 1974, in 922 O.G. 1016, now MPEP 803, as authorizing the rejection. That notice also, and solely, relies on §121 for authority. In view of our decision here, it is obvious that the substance of the notice and the MPEP provision corresponding to it are as lacking in foundation as the rejection we are reversing.

<sup>3</sup> This is the essence of the test for independence and distinctness set forth in the third paragraph of the Commissioner's notice of May 1, 1974, in determining whether the examiner has authority to reject a claim, under the fourth paragraph of the notice.

<sup>1</sup> Even the dissenting member of the board, who felt the "Markush" claims there involved were not to "independent and distinct" inventions, agreed that §121 was a proper "legal basis" for a rejection.



would suggest that the use of both kinds of filtration in a microanalyser of the type claimed here would eliminate the effects of variable initial velocities of the secondary ions while still preserving the optical image of the surface under investigation, we are unwilling to conclude that such use would have been obvious.

Essentially the same considerations apply to claims 5-7. The examiner rejected those claims under § 103 on Herzog in view of Noda,<sup>2</sup> which shows the use of an ion mirror in a mass spectrometer. The board affirmed, stating that it would be obvious to substitute Noda's ion mirror in Herzog's device. That position again overlooks the optical features of appellants' microanalyser which are designed to preserve the image of the sample surface. Neither Herzog nor Noda, taken separately or together, disclose or render obvious those optical features, and we must accordingly reverse the board's rejection of claims 5-7.

The decision is reversed.

### Court of Customs and Patent Appeals

In re ROBINS

No. 8313

Decided Aug. 13, 1970

#### PATENTS

##### 1. Pleading and practice in Patent Office — Rejections (§54.7)

With respect to 35 U.S.C. 112, it is essential that specific requirement of statute on which rejection is based be clearly identified.

##### 2. Specification — Sufficiency of disclosure (§62.7)

If rejection was intended under first paragraph of 35 U.S.C. 112, it must be reversed inasmuch as specification contains statement of applicant's invention which is as broad as applicant's broadest claims, and inasmuch as sufficiency of specification to satisfy "best mode" requirement of section 112 and to enable one skilled in the art to practice applicant's process as broadly as it is claimed has not been questioned.

<sup>2</sup> U. S. Patent 3,126,477, issued March 24, 1964.

##### 3. Specification — Sufficiency of disclosure (§62.7)

It may not be necessary, in order to support broad generic language in claim, that specification be equally broad in its naming, and in use of examples, of representative compounds encompassed by claim language; mention of representative compounds encompassed by generic claim language is not required by 35 U.S.C. 112 or any other provision of statute but, where no explicit description of a generic invention is found in specification, mention of representative compounds may provide an implicit description upon which to base generic claim language; representative examples are not required by statute and are not an end in themselves; rather, they are a means by which certain requirements of statute may be satisfied; thus, inclusion of a number of representative examples in specification is one way of demonstrating the operability of a broad chemical invention and, hence, establishing that utility requirement of section 101 has been met; it also is one way of teaching how to make and/or use claimed invention, thus satisfying that aspect of section 112.

##### 4. Specification — Sufficiency of disclosure (§62.7)

35 U.S.C. 112 does not require that specification convince persons skilled in the art that assertions therein are correct.

##### 5. Construction of specification and claims — Broad or narrow — In general (§22.101)

Claim language must be given its broadest possible meaning, in absence of special definitions by applicant.

##### Particular patents—Elastomers

Robins, Urethane Elastomers, claims 19 to 26 of application allowed; claims 27 and 28 refused.

Appeal from Board of Appeals of the Patent Office.

Application for patent of Janis Robins, Serial No. 199,644, filed June 4, 1962; Patent Office Group 140. From decision rejecting claims 19 to 28, applicant appeals. Affirmed as to claims 27 and 28; reversed as to claims 19 to 26.

DONALD M. SELL and KINNEY, ALEXANDER, SELL, STELDT & DELAHUNT, both of St. Paul, Minn. (JOHN H. LEWIS, JR., JOHN E. WITHERSPOON, and STEVENS, DAVIS,

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MILLER & MOSHER, all of Arlington, Va., of counsel) for appellant.

S. WM. COCHRAN (R. E. MARTIN of counsel) for Commissioner of Patents.

Before WORLEY, Chief Judge, RICH, BALDWIN, and LANE, Associate Judges, and RICHARDSON, Judge, United States Customs Court, sitting by designation.

RICH, Judge.

This appeal is from the decision of the Patent Office Board of Appeals<sup>1</sup> affirming the rejection of claims 19-28 of application serial No. 199,644, filed June 4, 1962, entitled "Urethane Elastomers."

The claims on appeal are directed to a process for producing solid, non-cellular urethane polymers and to the resulting product. Appellant has discovered that "ionizable, halogen-free monoorgano mercuric compounds" are especially useful for catalyzing reactions between compounds having at least one reactive isocyanate group (-NCO) and compounds having at least one reactive hydroxyl group (-OH) to produce a solid, non-cellular polyurethane product. Appellant's contribution resides entirely in the catalyst used, the process being otherwise old. Referring to the catalysts useful in his process, appellant's brief states:

This class of compounds may for convenience be characterized by the formula



wherein R is an organo radical such as an alkyl or an aryl group joined directly to the mercury by a carbon-to-mercury bond, and X represents an organic or inorganic moiety joined to the mercury by some other bond than carbon \* \* \*, e.g., oxygen in the case of a hydroxyl or acid moiety, nitrogen in the case of the ammonium salts, etc. By definition in the specification compounds which are monoorgano-mercuric have "only one carbon-to-mercury bond" \* \* \*. [Emphasis ours.]

Appellant's brief also explains some of the advantages of the claimed process as follows:

Appellant's invention is that certain classes of mercuric compounds selectively catalyze the secondary hydroxyl-isocyanate (OH-NCO) reaction, and promote it apparently to the substantial exclusion of the water-isocyanate (H<sub>2</sub>O-NCO) reaction when small amounts of H<sub>2</sub>O are present in the same reactive system with reactive OH groups \* \* \*. Since these classes of

mercuric compounds show no such selectivity when studying their effects in NCO-H<sub>2</sub>O or NCO-OH reactive systems separately \* \* \*, this selectivity could not be predicted. This discovery is of far reaching commercial importance since it results in the ability to mix monomeric organic polyisocyanates and organic polymeric polyols with one another to provide normally liquid systems for the direct conversion into polymeric elastomers having predictable cure times and reproducible final properties even in the presence of considerable moisture \* \* \*. This was not possible before because other prior known catalytic soluble compounds of metals were either found to indiscriminately promote the water-isocyanate reaction as well as the hydroxyl-isocyanate reaction or to be inhibited by water \* \* \*.

While the NCO-H<sub>2</sub>O and NCO-OH reaction competition is encouraged in the formation of polyurethane foams as the carbon dioxide released in the reaction,  $\text{NCO} + \text{H}_2\text{O} \rightarrow \text{NHCONH} + \text{CO}_2$ , constitutes the foaming agent, such competition is an anathema to the formation of non-cellular solid polyurethane rubbers or elastomers. In the latter instance the  $\text{NCO} + \text{OH} \rightarrow \text{NHCOO}$  reaction is required to the exclusion of the NCO-H<sub>2</sub>O reaction since the presence of gaseous reaction products causes bubbling or otherwise results in rubbers or elastomers having inferior physical properties \* \* \*. [Emphasis ours.]

Claims 19-26 are directed to the above-described process and claims 27 and 28 to the products of the processes of claims 23 and 25, respectively. Claims 19-21 and 27 are representative:

19. A process for accelerating the urethane linkage forming reaction between isocyanate and hydroxyl groups in the formation of a urethane product, said process comprising reacting an organic compound having at least one reactive isocyanate group with an organic compound having at least one reactive hydroxyl group in the presence of a catalytic amount of an ionizable, halogen-free, monoorgano mercuric compound having a single carbon to mercury valence bond.

20. The process of claim 19 wherein said monoorgano mercuric compound is a phenyl mercuric compound.

21. The process of claim 19 wherein said monoorgano mercuric compound is a phenyl mercuric salt of a carboxylic acid.

27. A product made in accordance with the process of claim 23.

<sup>1</sup> Consisting of Federico and Mangan, Examiners-in-Chief, and Rebold, Acting Examiner-in-Chief, opinion by Mangan.

There are two prior art rejections under 35 U.S.C. 102 and 103, and at least one rejection under 35 U.S.C. 112. The latter rejection, which we consider first, was stated in the examiner's Answer as follows:

*Claims 19-28 stand rejected under 35 U.S.C. 112 on the grounds that same are not supported by the disclosure and are unduly broad.*

*It is the examiner's position that appellant has not disclosed a suitable number of mercuric compounds falling within the scope of the claims to justify the language in the claims.* Thus, the examiner is at a loss to figure out what compounds appellant intends to include with the scope of the claims. In the specification, appellant discloses two compounds which are readable on the claims [i.e., on which the claims read]: phenyl mercury acetate and phenyl mercury hydroxide.<sup>2</sup> On page 5 of the specification, appellant discusses in broad terms the catalyst contemplated.<sup>3</sup> Note that appellant states that the "mono-organo" portion of the catalyst may be "alkyl" or "aryl." The only example of "aryl" is phenyl. There are no examples of "alkyl." Note that no particular meaning for "aryl" has been ascribed to in the specification. \* \* \* In this regard, the instant case is similar to *In re Sus* \* \* \* [49 CCPA 1301, 306 F.2d 494, 134 USPQ 301 (1962)]. The board's attention is directed to the discussion at 134 USPQ at 304, column 2 and 305, column 1. Note, also that in *In re Sus* several, and not just one example of "aryl" appeared in the specification. \* \* \* The instant specification contains no examples of alkyl. \* \* \* the mono-organo portion of the catalysts is not limited to "aryl" and "alkyl." Thus an [sic, any ?] organic radical is included within appellant's recitations. \* \* \*

The salt portion of the mono-organo mercuric salt has not been given any particular meaning in the specification. \* \* \* Insofar as the recitation "salt of a car-

boxylic acid" in claim 21 is concerned, appellant has likewise failed to ascribe any particular meaning to the recitation. \* \* \* In short, it is impossible to ascertain with any degree of reliability what compounds appellant intends to include within the meaning of the language presently appearing in the claims. *In re Surrey* \* \* \* [54 CCPA 855, 370 F.2d 349, 151 USPQ 724 (1966).]

\* \* \* *In view of the fact that appellant has ascribed no particular meaning to the "mono-organo" and "salt" portions of his catalysts, it is submitted that the instant disclosure will not support the broad language of the claims.* *In re Sus*, supra. [Emphasis ours.]

The board affirmed the examiner, stating in part:

The term "mono-organo" is indefinite, since it obviously is intended to include the "phenyl mercuric salt of a carboxylic acid" (claim 21), which has two organic groups, phenyl and carboxyl.<sup>4</sup>

Our review of the arguments presented leads us to agreement with the examiner's conclusion that the claims fail to comply with 35 U.S.C. 112. The term "mono-organo" is indefinite for the reason we have given above. Furthermore, we consider the term "organo" to be far broader than is warranted by the compounds disclosed, even including those rather generally given in the paragraph at the top of page 5 of the specification. The field of organic chemistry is too immense and catalytic action too unpredictable to extrapolate phenyl even to aryl, much less to alkyl and then "organo." Precedent, in the form of such decisions particularly as *In re Surrey* [supra] \* \* \* and *In re Oppenauer*, 31 CCPA 1248 \* \* \* 143 F.2d 974, 62 USPQ 297 [(1944)], cited therein, are believed clear to this effect.

We find the examiner's Answer to be singularly unclear as to the particular requirement or requirements of §112 which were thought not to have been met.<sup>5</sup> The first, second and last sentences we have quoted from

<sup>4</sup>This is unquestionably a criticism never raised by the examiner.

[1] \* Our consideration of this appeal would have been immeasurably simplified had the examiner merely referred to specific language in § 112, or at least to the paragraph in which it is to be found. Perhaps more so with respect to § 112 than with any other section of the statute, it is essential for the orderly resolution of issues that the specific requirement on which the rejection is based be clearly identified.

<sup>2</sup>As observed by the board, a third specific compound, phenyl mercury octoate, is also disclosed and encompassed by the claims.

<sup>3</sup>The discussion to which the examiner here refers reads as follows:

Among this group [ionizable, halogen-free monoorgano mercuric compounds] are organo-mercuric acetate, borate, benzoate, methacrylate, hydroxide, phthalate, gluconate, salicylate, octoate, stearate, etc.; the organo substituent may be an open or closed chain organic radical which is inert to isocyanate-active hydrogen reactions, as for example an aryl or alkyl group.

the examiner's Answer (see our emphasis) suggest that the *specification* was thought to be deficient (§112, first paragraph) in some unstated respect. From the remainder of the examiner's remarks, however, it appears that he could not ascertain "what compounds appellant intends to include within the scope of the claims," which amounts to a contention that the *claims* are indefinite (§112, second paragraph). The board contributes to our uncertainty by first "agreeing" with the examiner that "the *claims* fail to comply with 35 U.S.C. 112" (second paragraph ?—emphasis ours) and then purportedly supporting this conclusion with observations about the immensity of the field of organic chemistry and the unpredictability of catalytic action (§112, first paragraph ?—§101?). From the board's second decision responding to a Request for Reconsideration, it is apparent that a §101 rejection was not intended. There the board stated with respect to appellant's acknowledgment that "some chemist might find an inoperable organo-substituent":

Neither the examiner's holding nor our decision was on this basis, but rather they were based on the *lack of reasonable support* for the immense breadth of the claim terminology. [Emphasis ours.]

[2] If the examiner and/or the board intended a rejection under the first paragraph of §112, it must be reversed inasmuch as the specification contains a statement of appellant's invention which is as broad as appellant's broadest claims, and inasmuch as the sufficiency of the specification to satisfy the "best mode" requirement of §112 and to enable one skilled in the art to practice appellant's process as broadly as it is claimed has not been questioned.

[3] Both the examiner and the board seem to have taken the position that in order to "justify," as the examiner said, or to "support," as the board said, broad generic language in a claim, the specification must be equally broad in its naming, and use in examples, of representative compounds

encompassed by the claim language. This position, however, misapprehends the proper function of such disclosure. Mention of representative compounds encompassed by generic claim language clearly is not required by §112 or any other provision of the statute. But, where no explicit description of a generic invention is to be found in the specification (which is not the case here) mention of representative compounds may provide an implicit description upon which to base generic claim language. See *In re Sus*, supra, cited by the examiner and discussed below. Similarly, representative examples are not required by the statute and are not an end in themselves. Rather, they are a *means* by which certain requirements of the statute may be satisfied. Thus, inclusion of a number of representative examples in a specification is *one* way of demonstrating the operability of a broad chemical invention and hence, establishing that the utility requirement of §101 has been met. It also is *one* way of teaching how to make and/or how to use the claimed invention, thus satisfying that aspect of §112. However, there has here been no contention by the Patent Office that any of these requirements has not been met. We therefore fail to attach any significance to the absence of representative examples.

In fairness to the examiner and the board, it is not difficult to see how they might have been led by the *Sus*, *Surrey*, and *Oppenauer* cases, which they cited, to take the position which they appear to have taken. These cases, however, are readily distinguishable from the present case.

In *Sus*, appellant used the terms "aryl and substituted aryl radicals" or "substituted and unsubstituted aryl radicals" in his claims. However, we found nothing in the way of express statements or *examples* in the specification that would teach one skilled in the art that "all 'aryl and substituted aryl radicals' were properly within the subject matter which appellants considered to be their invention." Accordingly we held that the claims were broader than the disclosure.\* (In this regard see note 4 of the opinion.) In the present case, there are express statements of appellant's inven-

\* Which reads in pertinent part:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same \*\*\*

Which reads in pertinent part:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which applicant regards as his invention.

\* In *Sus*, the rejection was based on the second paragraph of §112. For the reasons given in *In re Halleck*, 57 CCPA \_\_\_\_\_, 422 F.2d 911, 164 USPQ 647 (1970); *In re Borkowski*, 57 CCPA 946, 422 F.2d 904, 164 USPQ 642 (1970); and *In re Wakefield*, 57 CCPA 959, 422 F.2d 897, 164 USPQ 636 (1970), such rejections are more properly considered under the first paragraph of that section.

tion which are as broad as his claims, and Sus therefore is not in point.

In Surrey, where the issues were (1) sufficiency of the disclosure to teach "how to use" the claimed compounds (§ 112, first paragraph) and (2) sufficiency of the *proof* that the compounds were in fact useful (§ 101), we stated, 151 USPQ at 730:

[A]ppellant here has failed to provide those of ordinary skill in the art, the Patent Office and this court, reasonable assurance, *as by adequate representative examples*, that the compounds falling within the scope of the claim will possess the asserted usefulness. [Emphasis ours.]

[4] Since § 112 does not require that a specification *convince* persons skilled in the art that the assertions therein are correct and since the above statement says "as by adequate representative examples" (emphasis ours), it *cannot* be reasonably inferred from Surrey, that the mentioned assurance *must* be provided by examples in the specification as opposed, for example, to affidavits as provided for by Rule 132. Since neither of the issues in Surrey is raised here, this case also is not in point.

In Oppenauer, somewhat as in Sus, several materials were recited more broadly in the claims than they were disclosed in the specification. As in Surrey, the sufficiency of the "how to use" disclosure of the specification was questioned and the court held that the specification did not contain a teaching that all of the materials of one type recited in the claims were "capable of accomplishing the desired result." We do not have a comparable situation here.

We turn now to the possibility that the examiner intended a rejection of the claims as being indefinite (§ 112, second paragraph). The examiner points out that appellant does not ascribe any *special* meaning to terms such as "organo" and "salt of carboxylic acid" and to the "salt" portion of his catalyst. From this he concludes that

it is impossible to ascertain with any degree of reliability what compounds appellant intends to include within the meaning of the language presently appearing in the claims.

[5] The examiner, however, was able to state, "Thus an [sic, any ?] organic radical is included within appellant's recitations." He also cited four foreign patents<sup>2</sup> to show various radicals which he apparently con-

sidered to be rather exotic and which the terms used in the claims would encompass in the absence of special meanings. This ability of the examiner to enumerate radicals encompassed by the claim language points up, we think, the weakness of the indefiniteness argument. Giving the language its broadest possible meaning, as we are bound to do in the absence of special definitions by appellant, the breadth of the claims insofar as the catalyst is concerned is indeed immense. However, "Breadth is not indefiniteness." In re Gardner, 57 CCPA \_\_\_\_\_, 427 F.2d 786, 166 USPQ 138 (1970).

Apparently interpreting the "monoorgano" as limiting the number of organic radicals possible in appellant's catalyst to one, the board held this expression to be indefinite because

it obviously is intended to include the "phenyl mercuric salt of a carboxylic acid" (claim 21), which has two organic groups, phenyl and carboxyl.

Appellant's specification, however, makes it perfectly clear that it is the number of *carbon-to-mercury* bonds, rather than the number of *organo groups*, that is restricted to one by the "motto" in the expression "monoorgano mercuric compound." Thus the specification states:

Presently preferred divalent mercury containing compounds are the \*\*\* ionizable mono-organo-mercuric compounds (*which contain only one carbon-to-mercury bond*). [Emphasis ours.]

The sense in which appellant uses the expression "monoorgano mercuric compound" is also consistent with the following definition from Hack's Chemical Dictionary (3rd ed.), cited by both appellant and the solicitor:

*organometallic. Pertaining to the carbon-metal linkage. o. compounds.* A class of compounds of the type R-M, where R is an alkyl or aryl radical and M is a metal; e.g., PbEt<sub>4</sub>, tetraethyl lead; R-Mg-X, alkyl-magnesium-halide. [Emphasis ours.]

In its second opinion the board noted that appellant's use of the phrase "having a single carbon to mercury valence bond" in some of the claims to qualify the expression "monoorgano mercuric compound" creates somewhat of a redundancy since in the specification the former expression is used to define the latter. We find, however, that rather than rendering the claims indefinite, this redundancy merely removes any question as to the meaning of the latter expression. We therefore cannot agree with the board's reasons for holding appellant's claims indefinite.

<sup>2</sup>Australian, 160,814, Jan. 1955; Australian, 208,961, June 1957; British, 692,953, June 1953; and Canadian, 706,906, Mar. 1965.

There remain for our consideration two prior art rejections. The references relied on are:

Windemuth et al. 3,073,702 Jan. 15, 1963 (filed Oct. 22, 1959)

Kaestner et al. 3,136,732 June 9, 1964 (filed Oct. 7, 1960)

Journal of Applied Polymer Science, Vol. IV, No. 11, pp. 207-11 (1960)

The examiner rejected all the claims under 35 U.S.C. 103 as "unpatentable over the combination of Kaestner \*\*\* and Journal of Applied Polymer Science" (hereinafter "JAPS"), and claims 27 and 28 under 35 U.S.C. 102 as "fully met by Windemuth."

Windemuth et al. ("Windemuth") relates to the production of polyurethane products from isocyanates and polyethers using catalysts which differ from those used by appellant. Windemuth discloses that the best results are obtained from divalent or tetravalent tin compounds, e.g., stannic chloride and dibutyl tin dilaurate.

Kaestner et al. ("Kaestner") discloses a process of making polyurethanes in which the catalyst is a metal naphthenate. Mercury

naphthenate is disclosed as being preferred.<sup>10</sup>

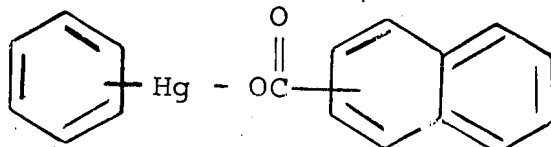
The JAPS article reports the results of a study in which the catalytic activities of a wide variety of metallic compounds for isocyanate-hydroxyl reactions were determined. The article states:

A list of the type compounds in a roughly descending order of catalytic activity is Bi, Pb, Sn, triethylenediamine, strong bases, Ti, Fe, Sb, U, Cd, Co, Th, Al, Hg, Zn, Ni, trialkylamines, Ce, Mo, V, Cu, Mn, Zr, and trialkyl phosphines. [Emphasis ours.]

Diphenyl mercury appears to have been the only mercury compound tested.

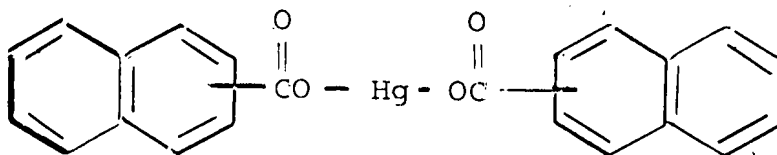
The examiner explained the rejection of all the claims on Kaestner and JAPS as follows:

The claims in the instant application are directed to the use of a mono-organo mercury compound having a single carbon-mercury bond as catalysts for the preparation of polyurethanes. Included within the scope of appellant's mercury compounds is phenyl mercury naphthenate. The structural formula of phenyl mercury naphthenate is:

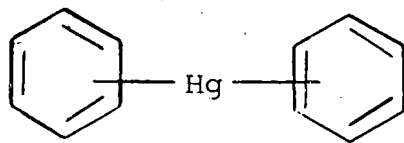


Kaestner et al. disclose the use of mercury naphthenate as a catalyst for the preparation of polyurethanes. \*\*\* Mer-

cury naphthenate has the following structural formula:



JAPS discloses the use of diphenylmercury as a catalyst for the preparation of polyurethanes. \*\*\* The structural formula of diphenylmercury is:



Phenyl mercury salts of carboxylic acids are known in the art. \*\*\* Appellant does not challenge this position.

The Board is invited to compare the structural formulae of the prior art catalysts and appellant's catalyst. Moreover, the

Board will note that the utility (properties) of the mercury compounds is identical.

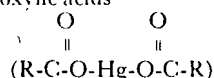
In view of the facts (1) that mercury naphthenate is a known catalyst for producing polyurethanes, as taught by Kaestner et al; (2) that diphenylmercury is a known catalyst for producing polyurethanes, as taught by JAPS; and (3) that appellant's organo-mercury-salts are known compounds; it is the Examiner's

<sup>10</sup> Appellant challenges the availability of Kaestner on the basis of a parent application filing date. The Patent Office denies his right to rely on the parent. We find it unnecessary to consider this issue since we find the rejection based on this reference to be unsound on other grounds.

position that one skilled would find it obvious to use phenyl mercury naphthenate as a catalyst for producing polyurethanes.

From the foregoing it will be seen that the mercury naphthenate of Kaestner contains an -O-Hg-O- linkage, the diphenyl mercury catalyst of JAPS a -C-Hg-C- linkage, and appellant's compounds a -C-Hg-X- linkage, where "X" typically may be oxygen as in phenyl mercury naphthenate.

Appellant argues that his monoorgano-mercuric compounds (R-Hg-X) are of a different class than the diorgano-mercuric compounds (R-Hg-R) represented by the diphenyl mercury of JAPS and the mercuric salts of carboxylic acids



represented by the mercuric naphthenate of Kaestner. Appellant also points out differences in the catalytic action of the three classes of compounds. Specifically he notes that JAPS shows lead octoate (which JAPS reports as being one of the most active catalysts tested) to be 40 times more active than diphenyl mercury as a catalyst for isocyanate-hydroxyl reactions, while appellant's specification establishes lead octoate to be about comparable to his monoorgano-mercuric compounds under anhydrous conditions but much worse in the presence of even 0.1% of moisture. Comparing his mono-organo mercuric compounds with the mercuric salts of carboxylic acids, such as the mercuric naphthenate disclosed in Kaestner, appellant urges that the former are "more potent catalysts" and possess "the further unexpected advantage, in the casting of one-shot rubbers, of enabling the liquid and pourable mixture which cures to the rubber to stay liquid and pourable for a long period of time while still not increasing the total gelation time \*\*\*." Although we do not find the latter advantage to be substantiated in the record, comparative examples in appellant's specification do support the conclusion that the monoorgano mercuric compounds are the more potent catalysts. Having considered all the arguments and evidence of record and the board's observation about the unpredictability of catalytic action, we conclude that the rejection based on Kaestner and JAPS must be reversed.

We affirm, however, the rejection of product-by-process claims 27 and 28 under 35 U.S.C. 102 on Windemuth which discloses the production of polyurethanes using various tin compounds as catalysts. The examiner took the position that the claimed

products and certain of the polyurethane products of Windemuth would not differ materially. Appellant submitted a Rule 132 affidavit containing comparisons of the physical properties of polyurethanes produced using stannic chloride, dibutyl tin chloride, and phenyl mercuric acetate, the first two being disclosed in Windemuth and the last being one of appellant's catalysts. The examiner criticized the affidavit because of appellant's choice of tin compounds disclosed in the reference. He felt that a tin compound containing both salt groups and carbon-metal groups, such as dibutyl tin dilaurate disclosed in Windemuth, would have been more similar in structure to appellant's catalysts and therefore should have been used in the comparison.<sup>11</sup> Appellant attempts to defend his choice by pointing out that the reference discloses stannic chloride as being a preferred catalyst. However, in considering this rejection, we are not concerned with superiority of the catalysts but rather with differences, if any, in the products produced. We agree with the examiner that to be persuasive the affidavit should have included in the comparison a product obtained using a catalyst more similar in structure to appellant's catalysts.

In summary, we reverse the rejections under § 112 and § 103 and affirm the rejection under § 102.

Accordingly, the decision of the board is reversed as to claims 19-26 and affirmed as to claims 27 and 28.

WORLEY, Chief Judge, took no part in the decision of this case.

### Court of Customs and Patent Appeals

In re HOSTETTLER AND PROOPS

No. 8283

Decided Aug. 20, 1970

### PATENTS

#### Particular patents—Polyurethane

Hostettler and Proops, Stabilized Polyurethane Composition, claims 1 to 3, 9, and 10 of application refused.

<sup>11</sup> Dibutyl tin dilaurate was compared with phenyl mercuric acetate in one example of appellant's specification, but the example is concerned only with the effect of water on catalytic activity and no details are given as to the properties of the products.

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There is no evidence Scott itself has infringed the patent by its own use.

The Court concludes that Scott actively induced infringement of United States Patent No. 2,678,265 in violation of Title 35, United States Code, Section 271(b).

WHEREUPON, IN CONCLUSION, and in accordance with the findings of facts and the conclusions of law in respect to the issue of validity of the patent made hereinbefore that Claim 2 of United States Patent No. 2,678,265 is invalid in that such patent covers the use of inoperable compounds, the Court holds that the patent in suit is invalid.

Counsel are directed to submit to the Court within twenty (20) days of the filing of this Opinion, a judgment in accordance herewith.

### Court of Customs and Patent Appeals

In re MARZOCCHI AND HORTON

No. 8431

Decided Apr. 15, 1971

### PATENTS

#### 1. Specification — Sufficiency of disclosure (§62.7)

Recitation of generic term "polyethyleneamine" must be taken as assertion by applicants that all of the "considerable number of compounds" which are included within generic term would, as a class, be operative to produce asserted enhancement of adhesion characteristics; Patent Office has no concern over breadth of term; its only relevant concern should be over truth of such assertion; first paragraph of 35 U.S.C. 112 requires nothing more than objective enablement; how such a teaching is set forth, either by use of illustrative examples or by broad terminology, is of no importance.

#### 2. Pleading and practice in Patent Office — Rejections (§54.7)

##### Specification — Sufficiency of disclosure (§62.7)

Specification disclosure which contains teaching of manner and process of making and using the invention in terms corresponding in scope to those used in describing and defining subject matter sought to be patented must be taken as in compliance with

enabling requirement of first paragraph of 35 U.S.C. 112 unless there is reason to doubt objective truth of statements contained therein which must be relied on for enabling support; assuming that sufficient reason for such doubt exists, a rejection for failure to teach how to make and/or use will be proper on that basis; such a rejection can be overcome by suitable proofs indicating that teaching contained in specification is truly enabling.

#### 3. Pleading and practice in Patent Office — Rejections (§54.7)

##### Specification — Sufficiency of disclosure (§62.7)

In field of chemistry generally, there may be times when well-known unpredictability of chemical reactions will alone be enough to create reasonable doubt as to accuracy of broad statement put forward as enabling support for claim; this will especially be the case where statement is, on its face, contrary to generally accepted scientific principles; most often, additional factors, such as teachings in pertinent references (not necessarily prior art), will be available to substantiate doubts that asserted scope of objective enablement is in fact commensurate with scope of protection sought and to support any demands based thereon for proof; it is incumbent upon Patent Office, whenever a rejection on this basis is made, to explain why it doubts truth or accuracy of statement in supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with contested statement; otherwise, there would be no need for applicant to support his presumptively accurate disclosure.

#### Particular patents—Fiber Coatings

Marzocchi and Horton, Fiber Coatings — Nitrogen Compounds for Improving Adhesion of Vinyl Polymers to Glass, claims 6 and 12 of application allowed; claims 5 and 11 refused.

Appeal from Board of Appeals of the Patent Office.

Application for patent of Alfred Marzocchi and Richard C. Horton, Serial No. 470,618, filed July 8, 1965; Patent Office Group 140. From decision rejecting claims 5, 6, 11, and 12, applicants appeal. Affirmed as to claims 5 and 11; reversed as to claims 6 and 12.

HERMAN HERSH AND McDOUGALL, HERSH, SCOTT & LADD, both of Chicago, Ill.



(STAEIN & OVERMAN, Toledo, Ohio, and GEORGE A. DEGNAN, Washington, D. C., of counsel) for appellants.

S. WM. COCHRAN (FRED W. SHERLING of counsel) for Commissioner of Patents.

Before RICH, ALMOND, BALDWIN, AND LANE, Associate Judges, and DUFFEE, Judge, United States Court of Claims, sitting by designation.

BALDWIN, Judge.

This is an appeal from the decision of the Patent Office Board of Appeals which affirmed the final rejection of claims 5 and 11 of appellants' application<sup>1</sup> under 35 U.S.C. 103 as unpatentable in view of Werner<sup>2</sup> and of claims 6 and 12 under 35 U.S.C. 112 as being based on an inadequate disclosure. Claims 4 and 10 stand allowed.

### The Invention

The subject matter of the claims on appeal involves a technique for improving the adhesion characteristics between glass fibers and vinyl polymer resins. Claim 5 is representative and reads as follows:

5. In the combination of glass fibers and a vinyl polymer resin composition present as a coating on the glass fiber surfaces, the improvement which comprises mixing the vinyl polymer resin, prior to coating of the glass fibers, with an amine compound in an amount corresponding to 2-10% by weight of the vinyl polymer resin, and in which the amine compound is monomeric vinyl pyrrolidone.

Claim 11 is drawn to the same concept as claim 5, but defines the invention as "a method of producing glass fibers coated with polyvinyl resin strongly bonded to the glass fiber surfaces." Claims 6 and 12 differ from claims 5 and 11 respectively solely in the recitation of "polyethylenamine" as the critical "amine compound" additive.

### The Section 103 Rejection

Claims 5 and 11 were rejected "as obvious in the sense of 35 U.S.C. 103 over Werner." Werner, the sole reference relied upon here, is addressed to the improvement in the bonding relationship between glass and polyvinyl halide resins. The pertinent disclosure is as follows [emphasis added]:

<sup>1</sup> Serial No. 470,618, filed July 8, 1965, for "Fiber Coatings -- Nitrogen Compounds for Improving Adhesion of Vinyl Polymers to Glass" as a continuation-in-part of Serial No. 96,106, filed March 16, 1961.

<sup>2</sup> U. S. Patent No. 2,853,465, issued September 23, 1958.

I have found that polyvinyl halide resins may be successfully modified so as to obtain excellent glass adhesion by employing a mixture of a polyvinyl halide and a polymer of N-vinyl pyrrolidone. By employing a mixture containing from 80 to 97% of a polyvinyl halide and from 20 to 3% of a polymer of N-vinyl pyrrolidone, which term includes homopolymers of vinyl pyrrolidone and copolymers with other polymerizable monomers, a composition is obtained having extremely high adhesion to all glass surfaces.

On the basis of this teaching the examiner took the position, accepted by the board, that the claimed use of *monomeric* vinyl pyrrolidone rather than Werner's *polymeric* vinyl pyrrolidone would be obvious to one of ordinary skill in the art since Werner's teaching would indicate to "one skilled in the art \*\*\* that it is the vinyl pyrrolidone moiety that is enhancing the adhesion." It was also suggested by the examiner that since the claims recite no temperature conditions for the coating operation and since monomers polymerize when heated, the claims could possibly cover circumstances wherein the monomer is polymerized during application. The board appears to have accepted this suggestion and to have extended it even further. It stated:

All of Werner's examples specify heating at elevated temperatures (110°C.-130°C., 165°C., 325°F., 350°F.) with and without elevated pressures. Appellants' specification says nothing about retaining the vinyl pyrrolidone in monomeric form, much less anything about "maximizing adhesion" by preventing polymerization. Indeed, the very designation of the vinyl pyrrolidone as a "monomeric" material introduced into a polymer system for the purpose of altering the properties of such system implies subsequent polymerization of the monomer. Appellants' further argument that the monomer has entirely different capabilities and solubilities than the polymer is also unpersuasive.

Appellants' position on appeal in response to these assertions by the examiner and board is largely to stress again the "marked difference between the properties and characteristics of a polymer as compared to a monomer," and to object to the "purely conjectural" assertion that the monomer polymerizes in the coating after it is applied. Additionally, appellants make the following contention:

Even if it were assumed that appellants' monomeric vinyl pyrrolidone is polymerized when present in the polyvinyl chloride coating, there is no teaching or sug-

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gestion in Werner that the use of monomeric vinyl pyrrolidone has any efficacy whatsoever in compositions of the type disclosed and claimed. The basis suggested by the Patent Office for the rejection is tantamount to the allegation it would be "obvious to try" the monomer. This "test" of obviousness has been frequently repudiated by this court.

The sole issue is, of course, whether the Werner teaching does suggest to a person having ordinary skill in this art that the use of monomeric vinyl pyrrolidone would have the efficacy indicated in the appealed claims. We agree with appellants that whether the monomer polymerizes is irrelevant, at least in this regard. What is relevant, however, and here determinative, is the examiner's assertion that the Werner teaching would suggest that it is the vinyl pyrrolidone moiety alone and not some other characteristic peculiar to a polymer which is efficacious in producing the desired adhesion enhancement.<sup>1</sup> In the absence of anything to rebut this assertion, which is reasonable on its face, we are constrained to accept it as fact. The inferences which follow from such fact, i.e., that the monomer would possess this same characteristic and that one of ordinary skill would recognize such fact, are inescapable.

It is acknowledged that the above line of reasoning may be viewed as being tantamount to drawing the inference that, to one possessing the ordinary level of skill in this art, it would be "obvious to try" the monomer. Nevertheless, such an *inference of fact* may, at times, be enough to justify drawing the ultimate *conclusion of law* that the claimed subject matter as a whole would have been obvious under section 103. We are satisfied that the circumstances of this case justify an initial conclusion of obviousness. Since the record before us contains nothing to rebut that conclusion, the decision with regard to claims 5 and 11 must be affirmed.

#### The Section 112 Rejection

Claims 6 and 12, which recite the use of "polyethylenamine" as the adhesion enhancer, were criticized by the examiner as be-

<sup>1</sup>Indeed, the reasonableness of such an assertion is confirmed by the very disclosure contained in appellants' application which indicates that efficacious adhesion enhancers are those "organic nitrogenous compounds which are characterized both by an organic constitution which is compatible with the vinyl polymers and by a polarity expressed in the nitrogen function." As also pointed out by appellants in their brief (about which more will be said later), the nature of the present invention resides in the use of *amine* compounds, broadly, as adhesion enhancers.

ing based on a disclosure which was not enabling under the first paragraph of 35 U.S.C. 112. The board affirmed his rejection of those claims with the following comment.

The term is obviously generic to a considerable number of compounds varying in the number of ethylene groups, the number of amine groups and the relationship of the polyethylene groups to the amine groups, and accordingly does not provide a reasonable guide for those seeking to improve the adherence of vinyl resins to glass.

We will reverse the board's decision on this rejection since we are unable to find sufficient justification for the holding that appellants' disclosure is not enabling.

[1] Turning specifically to the objections noted by the board as indicated above, it appears that these comments indicate nothing more than a concern over the *breadth* of the disputed term. If we are correct, then the relevance of this concern escapes us. It has never been contended that appellants, when they included the disputed term in their specification, intended only to indicate a single compound. Accepting, therefore, that the term is a generic one, its recitation must be taken as an assertion by appellants that all of the "considerable number of compounds" which are included within the generic term would, as a class, be operative to produce the asserted enhancement of adhesion characteristics. The only relevant concern of the Patent Office under these circumstances should be over the *truth* of any such assertion. The first paragraph of § 112 requires nothing more than objective enablement. How such a teaching is set forth, either by the use of illustrative examples or by broad terminology, is of no importance.

[2] As a matter of Patent Office practice, then, a specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented *must* be taken as in compliance with the enabling requirement of the first paragraph of § 112 *unless* there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. Assuming that sufficient reason for such doubt does exist, a rejection for failure to teach how to make and/or use will be proper on that basis; such a rejection can be overcome by suitable proofs indicating that the teaching contained in the specification is truly enabling. //

[3] In the field of chemistry generally, there may be times when the well-known

unpredictability of chemical reactions will alone be enough to create a reasonable doubt as to the accuracy of a particular broad statement put forward as enabling support for a claim. This will especially be the case where the statement is, on its face, contrary to generally accepted scientific principles. Most often, additional factors, such as the teachings in pertinent references,<sup>4</sup> will be available to substantiate any doubts that the asserted scope of objective enablement is in fact commensurate with the scope of protection sought and to support any demands based thereon for proof. In any event, it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure. Cf. *In re Gazave*, 54 CCPA 1524, 379 F.2d 973, 154 USPQ 92 (1967); *In re Chilowsky*, 43 CCPA 775, 229 F.2d 457, 108 USPQ 321 (1956).

In the present case, the circumstances we see do not support the reasonableness of any doubts which the Patent Office might have had concerning the adequacy of appellants' specification disclosure to support these claims. In fact, those circumstances tend to strengthen rather than weaken appellants' claim to the breadth of protection they seek. In the first place, it has not been asserted by the Patent Office that the chemical properties of known polyethylenamines vary to such an extent that it would not be expected by one of ordinary skill in this art that any such compound would possess the necessary capability of enhancing adhesion. Additionally, we note that polyethylenamine is listed in appellants' specification as being only one of a much larger class of amine compounds possessing this necessary characteristic. Finally, we recognize (as did the examiner) the generic nature of appellants' broader concept, i.e., that the desired property of adhesion enhancement stems largely from the amine moiety. It does appear that variation of certain of the secondary factors mentioned by the examiner, such as molecular weight or proportion of ethylene groups, might influence to some degree or even mask the essential "amine" property of the polyethylene amine or its obviously equally essential com-

<sup>4</sup>Not necessarily *prior* art references, it should be noted, since the question would be regarding the *accuracy* of a statement in the specification, not whether that statement had been made before.

patibility with vinyl polymers. However, we see no basis to conclude that the ready avoidance of this result would not be within the level of ordinary skill in this art. Compare *In re Skrivan*, 57 CCPA 1201, 427 F.2d 801, 166 USPQ 85 (1970).

Taking all these circumstances into consideration, we are constrained to conclude that the record before us contains insufficient grounds for questioning the accuracy of appellants' teaching that *any* polyethylenamine (obviously excepting those whose essential "amine" characteristics and compatibility with vinyl polymers would be masked by the secondary factors mentioned) will function to accomplish the asserted result. It follows that claims 6 and 12 must be held to be supported by a disclosure which is in compliance with the requirements of the first paragraph of 35 U.S.C. 112.

### Summary

The decision of the board regarding claims 5 and 11 is *affirmed*; that dealing with claims 6 and 12 is *reversed*.

### New York Supreme Court, Special Term, New York County

BUSH V. ELECTRO-VOICE, INCORPORATED,  
et al.

No. 7909/67 Decided June 11, 1968

### UNFAIR COMPETITION

#### 1. Trade secrets — Parties bound (\$68,913)

If defendant, actually or constructively, had knowledge or notice that devices purchased by it through third party constituted assets and trade secrets of plaintiff and that right thereto had been wrongfully acquired or appropriated by third party, it cannot escape consequences that may be visited by its receipt of such disclosures.

Action by Martin J. Bush, Trustee in Bankruptcy for Paralan Electronics Corporation, against Electro-Voice, Incorporated, F. E. Industries, Inc., Carduner Sales Corporation, Eugene S. Carduner, and Melvin Zalkin for misappropriation of trade secrets. On motion by Electro-Voice, Incorporated, for summary judgment. Motion granted in part and denied in part.

See also 169 USPQ 372.

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plaintiff.

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speedily done at minimal cost, defendants are engaging in mass piracy on a custom basis. To view this activity as a form of "home recording" would stretch imagination to the snapping point. To refuse to protect plaintiffs' exclusive reproduction and publication rights in such circumstances would defeat the very purpose of the sound recording amendment and nullify the intent of Congress.

Accordingly, plaintiffs are entitled to a preliminary injunction which shall be binding upon defendants and others as provided in Rule 65(d), F. R. Civ. P., and shall restrain defendants pending the determination of this action from:

1. Using or permitting the use of Make-A-Tape systems installed in defendants' stores for the purpose of making copies of tape sound recordings as to which plaintiffs have enforceable copyrights.

2. Offering to or permitting the use by customers of copyrighted sound recordings of plaintiffs maintained in defendants' stores for the purpose of making copies on Make-A-Tape systems installed in such stores.

The foregoing preliminary injunction shall become effective upon the giving of security by plaintiffs in the aggregate amount of \$10,000.

The court also finds merit in defendants' application for return of the Make-A-Tape systems and related parts heretofore seized. Return of such property to defendants is therefore ordered, subject to the aforesaid preliminary injunction.

The foregoing constitutes the findings of fact and conclusions of law of the court for purposes of Rule 52, F. R. Civ. P.

### Court of Customs and Patent Appeals

In re WOLFRUM AND GOLD

No. 8882

Decided Nov. 1, 1973

### PATENTS

#### 1. Claims — In general (§20.01)

##### Joinder of invention — In general (§42.1)

Second paragraph of 35 U.S.C. 112 merely states that specification shall conclude with one or more claims which clearly and distinctly describe invention which applicant believes he invented; it provides no authority for rejecting claim on basis of Patent Office determination that claim contains a plurality

of inventions; scope of subject matter is governed not by examiner's conception of the "invention" but by that "which the applicant regards as his invention"; when boundaries of patent protection sought are so limited, the only concern must be directed to preciseness and definiteness of claim language employed; Office's determination that earlier, separate claims encompass a "plurality of different inventions" cannot serve, under section 112, as basis for rejection of a later combined claim; applicant is free under that provision to set metes and bounds of "his invention" as he sees them; subsequent compliance with Office restriction requirement with traverse cannot be considered a voluntary realignment of claim boundaries or a concession that more than one invention was originally claimed.

#### 2. Joinder of invention — In general (§42.1)

##### Prior adjudication — Applications for patent (§56.05)

Whether plurality of inventions had been claimed was not settled by restriction requirement and Commissioner's denial of petition therefrom, since, pending appeal to Board from rejection of claims kept that issue alive.

##### Particular patents—Dyestuffs

Wolfrum and Gold, Azo Dyestuffs, claims 11 and 12 of application allowed.

#### Appeal from Board of Appeals of the Patent Office.

Application for patent of Gerhard Wolfrum and Heinrich Gold, Serial No. 591,141, filed Nov. 1, 1966; Patent Office Group 123. From decision rejecting claims 11 and 12, applicants appeal. Reversed; Baldwin, Judge, concurring with opinion.

EARL L. TYNER, JOHN F. MATHEWS, and PLUMLEY & TYNER, all of Arlington, Va., for appellants.

MICHAEL G. GILMAN, New York, N. Y., amicus curiae.

S. WM. COCHRAN (JACK E. ARMORE of counsel) for Commissioner of Patents.

Before MARKEY, Chief Judge, and RICH, ALMOND, BALDWIN, and LANE, Associate Judges.

MARKEY, Chief Judge.

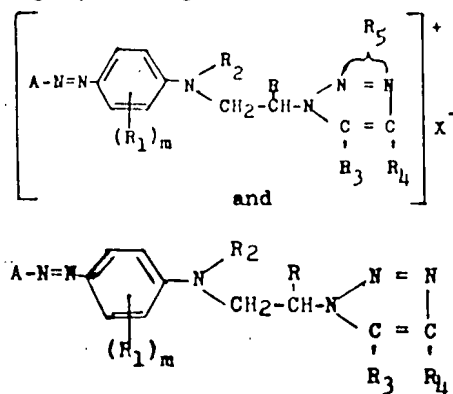
This appeal is from the decision of the Board of Appeals affirming the rejection under 35 U.S.C. 112 (second paragraph) of claims 11 and 12 of appellants' application, serial No. 591,141, filed November 1, 1966, for "Azo Dyestuffs." We reverse.

### The Invention

The invention relates to novel azo dyestuffs which may exist in both the tertiary amine form (water-insoluble) and the quaternary salt form (water-soluble). Conversion from one state to the other is said to be a well known basic reaction.

Claim 11 covers both forms:

11. An azo dyestuff selected from the group consisting of



wherein R stands for hydrogen or methyl;  $R_1$  is a member selected from the group consisting of chloro, bromo, lower alkyl, trifluoro lower alkyl, lower alkoxy, and acetyl-amino; m is an integer from 0 to 2;  $R_2$  stands for hydrogen, lower alkyl, or substituted lower alkyl, wherein the substituents are selected from the group consisting of cyano and ethoxy carbonyl;  $R_3$  and  $R_4$  are independently selected from the group consisting of hydrogen, lower alkyl, lower alkoxy methyl, phenyl, chlorophenyl, bromophenyl, lower alkyl phenyl, carboxylic acid, carbolower alkoxy;  $R_5$  is selected from the group consisting of lower alkyl and benzyl; A is selected from the group consisting of phenyl, substituted phenyl, thiazol (1, 3)-2-yl, 5-nitro thiazol (1, 3)-2-yl, benzothiazol (1, 3)-2-yl, 6-chloro benzothiazol (1, 3)-2-yl, 6-ethoxy benzothiazol (1, 3)-2-yl, 3-phenyl-thiadiazol (1, 2, 4)-5-yl, and triazol (1, 2, 4)-3-yl, wherein the substituents on said phenyl radical are members of the group consisting of halogen, lower alkyl, lower alkoxy, nitro, cyano, carboxy trifluoromethyl, carboxy lower alkyl, sulphony lower alkyl, carbonamide, lower alkyl carbonamide, dilower alkyl carbonamide, sulfonamide, lower alkyl sulfonamide, and dilower alkyl sulfonamide; X stands for an anion; and wherein the alkyl groups contain from 1-4 carbon atoms; said dyestuff being free of sulphonic acid groups.

Claim 12 is restricted to the tertiary amine species.

### The Rejection

Appellants originally submitted separate claims to the tertiary amine compounds and the quaternary ammonium salts. Restriction to one of these forms was required by the examiner on the basis of diverse utilities, the water-soluble quaternary salts being considered "distinct" from the insoluble dyestuffs of the intermediate tertiary amine form. An election was also required between the species "of patently distinct inventions" wherein the diazo component was phenyl-thiadiazol and substituted phenyl. The required elections of inventions and species were made with traverse and submission of additional claims, including claim 11 which presented the two forms as members of a Markush group. The examiner then rejected claims 11 and 12 under the second paragraph of 35 U.S.C. 112 because of the combination of forms previously held subject to restriction (claim 11) and the combination of phenyl and thiazole diazo components (both claims).

Appellants then petitioned the Commissioner under Rule 144, seeking reversal of the underlying restriction requirement. The petition was denied and the matter of the allegedly improper Markush groupings went to appeal. In the Examiner's Answer the position was set forth that the two groupings lacked the "requirements of proper Markush formulation," these "requirements" being that "the whole compounds [must] enjoy a recognized community of physical or chemical characteristics not repugnant to scientific classification coupled with utility."

The board found it unnecessary to go into any discussion of prior decisions on Markush practice and instead stated the issue simply as "whether or not a plurality of inventions, which could not be separately claimed in a single case, could be claimed together in one claim." The question of whether the "inventions" were properly subject to restriction was said to have been "settled by the examiner's ruling and the decision on petition \* \* \*."

The board then went on to sustain the rejection, holding:

" \* \* \* We believe that under 35 U.S.C. 112 an appellant does not definitely and accurately point out his invention when he assembles a plurality of different inventions in a single claim. \* \* \*"

### Opinion

[1] Appellants' basic contention is that the second paragraph of 35 U.S.C. 112<sup>1</sup> merely

<sup>1</sup> 35 U.S.C. 112, second paragraph, reads:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the ap-

states that the specification shall conclude with one or more claims "which clearly and distinctly describe the invention which the applicant believes he invented" and provides no authority for rejecting a claim on the basis of an "arbitrary" Patent Office determination that the claim contains a plurality of inventions.

We agree. In recent years this court has fully set forth the statutory requirements of § 112. The first sentence of the second paragraph in particular has been construed as a requirement that applicant "particularly point out and distinctly claim the *subject matter sought to be patented*." In re Borkowski, 57 CCPA 946, 951, 422 F.2d 904, 909, 164 USPQ 642, 645 (1970). Under this provision of § 112, the scope of the subject matter is governed not by the examiner's conception of the "invention" but by that "which the applicant regards as his invention." When the boundaries of the patent protection sought are so limited, the only concern under the second paragraph of § 112 must be directed to the preciseness and definiteness of the claim language employed. In re Borkowski, *supra*; In re Wakefield, 57 CCPA 959, 422 F.2d 897, 164 USPQ 636 (1970); In re Swinehart, 57 CCPA 1027, 439 F.2d 210, 169 USPQ 226 (1970).

Thus a determination by the Patent Office that earlier, separate claims encompass a "plurality of different inventions" cannot serve, under § 112, as the basis for a rejection of a later combined claim. An applicant is free under that provision to set the metes and bounds of "his invention" as he sees them. Subsequent compliance with an Office restriction requirement with *traverse* cannot be considered a voluntary realignment of the claim boundaries or a concession that more than one invention was originally claimed. Whether a [2] plurality of inventions had been claimed was not "settled" by the restriction requirement and the denial of the petition, the present appeal having in effect kept that issue alive. Appellant remained free to regard the claimed subject matter as his invention.

The solicitor argues that "[a]lthough the stated statutory basis for rejection cited by the examiner and the Board was 35 U.S.C. 112 (second paragraph), the rationale of the rejection implicitly also encompasses the provisions and mandate of 35 U.S.C. 101 and 121." We do not agree. The rejection before the board was made under 35 U.S.C. 112, second paragraph. Our review is of the board's decision on that rejection. The ramifications of the appli-

clicant regards as his invention. A claim may be written in independent or dependent form, and if in dependent form, it shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.

cation of sections 121 and 101 to a single Markush type claim allegedly containing a plurality of inventions is not here before us. See In re Haas, P.A. 9136, 179 USPQ 623, decided of even date.

The decision of the board is reversed.

BALDWIN, Judge, concurring.

The board stated that the issue raised was "whether or not a plurality of inventions, which could not be separately claimed in a single case could be claimed together in *one claim*." The board answered the question in the negative stating "[w]e believe that under 35 U.S.C. 112 an appellant does not definitely and accurately point out his invention when he assembles a plurality of different inventions in a single claim."

The phrase "could not be separately claimed in a single case" does not precisely describe the situation, and overly rigidifies the rule of law put forth by the board. Under the statute, specifically section 121, any number of inventions *can* be claimed in the same application even though they be wholly independent and unrelated to each other and patently, as well as patentably, distinct, if the Commissioner does not require restriction between them. The more precise question is whether independent and distinct inventions may be claimed in the same claim without violating section 112. The board's position appears to be that if the two inventions are independent and distinct, ipso facto, claims covering both of them are indefinite and inaccurate. I cannot agree with that proposition. Assuming arguendo that the claims before us cover independent and distinct inventions,<sup>1</sup> no reason has been put forth or is apparent why that fact renders them inaccurate or indistinct as to their meaning or as to what they cover. I therefore agree that the rejection before us should be reversed.

<sup>1</sup> Throughout the prosecution of this case appellants have strenuously contended that the tertiary amines and the quaternary amines are not independent. While the issue of "patentable distinctness" was dealt with by the examiner, the only reasoning in the record before us as to why they might be independent, the other requirement of 35 U.S.C. 121, is a statement that "[s]pecies are ordinarily considered independent inventions \* \* \*" in the decision on appellants' petition to the Commissioner under Patent Office Rule 144. This opinion assumes that they are independent within the meaning of the statute *purely* for the sake of argument, and no decision on the merits of that issue is intended to be implied.



CFR §1.141 deals *explicitly* with "independent and distinct inventions"<sup>4</sup> even permitting five of them to be patented on one application along with a generic claim. As to species in excess of five specifically claimed, it is implicit that they may still fall within the "coverage" of the generic claim even if separately patented. It is elementary patent law that the number of "species" "covered" by a patent having a generic claim is virtually without limit notwithstanding the limitation of Rule 141 to five species "specifically claimed." So the discretionary power to limit one application to one invention is no excuse at all for refusing to examine a broad generic claim — no matter how broad, which means no matter how many independently patentable inventions may fall within it.

Of course a broad claim may be unpatentable for any number of reasons, but we are not here dealing with a question of patentability under the statute but with a refusal to examine.

The only basis here claimed in support of the labels "improper" and "misjoinder" is the scope of the claim. That is not sufficient excuse.

As for the true meaning of the words "two or more independent and distinct inventions are claimed" in §121, being based — as they were — on the "division" practice existing in the then Patent Office in 1952, there can be no doubt they refer to separate inventions separately claimed and to a requirement to put separate claims in separate applications or at least to restrict one application to one claimed invention. There is no indication that enactment of §121 contemplated refusing examination to generic claims because of their scope or that applicants were to be denied the right to present single claims of any breadth they chose and have them examined.

The PTO effort of the past few years to justify its refusal to examine by issuing a "rejection" pursuant to the May 1, 1974, notice (MPEP 803) on the basis of §121 is mere semantic gamesmanship.

With respect to the remand to consider the "improper Markush" rejection of claims 1-6, it is my view, based on careful analysis of the rejections actually made,

that the PTO, following the May 1, 1974, notice (922 OG 1016), created a new kind of "improper Markush" rejection based on 35 USC 121 which we are reversing. There remains, however, a vast body of precedent antedating the 1974 notice on what proper "Markush" claims are. As I understand the majority's remand, it is for the purpose of examining claims 1-6 under the pre-notice law relating to Markush practice in the process of examining these claims on their merits. Until now, such examination has been refused because they "cover" or "embrace" too much, a basis of rejection we find impermissible.

## Court of Customs and Patent Appeals

In re Haas

No. 78-536

Decided June 30, 1978

### PATENTS

#### 1. Court of Customs and Patent Appeals — Issues determined — Ex parte patent cases (§28.203)

There is no issue before Court of Customs and Patent Appeals that claims are drawn to improper Markush groups where there is no rejection on that ground.

#### 2. Applications for patent — Divisional (§15.5)

Claims — Miscellaneous objections (§20.70)

Joinder of invention — In general (§42.01)

Pleading and practice in Patent Office — Rejections (§54.7)

Section 121 does not provide basis for rejection of claim.

#### Particular patents — Polymerization

Haas, Novel Polymerization Initiators, rejection of claim 7 and 8, reversed and remanded.

Appeal from Patent and Trademark Office Board of Appeals.

Application for patent of Howard C. Haas, Serial No. 821,511, filed May 2, 1969 continuation-in-part of application, Serial No. 630,222 filed Apr. 12, 1967. From decision rejecting claims 7 and 8, applicant appeals. Reversed and remanded.

<sup>4</sup> Note Rule 141's wording: "Two or more independent and distinct inventions may not be claimed in one application, *except* \* \* \*." (My emphasis.) Compare the wording of 35 USC 121.